

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Barry Appelman	Art Unit :	2174
Serial No. :	09/848,231	Examiner :	Peng Ke
Filed :	May 4, 2001	Conf. No. :	6250
Title :	PRESENCE STATUS INDICATOR		

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Pursuant to 37 C.F.R. § 41.41, Appellant responds to the Examiner's Answer as follows

(I) Status of Claims

(A) Status of Claims

Claims 1-80 are pending in this application, of which claims 1, 18, 23, 26, 57, 75, and 80 are independent. However, claims 57-80 were cancelled by way of a response filed concurrently with the Appeal Brief (and not yet entered). Further, the Examiner's Answer does not acknowledge or address this response timely filed with the Appeal Brief on March 6, 2006. All claims have been rejected, and only claims 1-56 have been appealed. For example, in the Examiner's Answer at page 2, paragraph (4) entitled "Status of Amendments after Final," the Examiner erroneously indicates that "No amendment after final has been filed." This statement is incorrect as the response, which cancelled claims 57-80 and therefore reduced issues for appeal, was timely filed on March 6, 2006 with the Appeal Brief. Therefore, the Examiner's Answer does not fully address all amendments filed on or before the filing date of the Appeal Brief. In addition, this amendment is shown as being received by the U.S. Patent Office's "PAIR" system as of March 6, 2006.

(B) Status of Amendments

Claims 57-80 were cancelled by way of a response filed on March 6, 2006 and not yet entered or considered by the Office. The response filed on March 6, 2006 should be entered as it reduces issues for appeal. Specifically, claims 57-80 have been cancelled. Claims 1-56, which have been appealed, have not been amended subsequent to the final rejection.

(2) Grounds of Rejection

Claims 1-4, 6-9, 11-68 and 71-80 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Glenn (U.S. Patent Application Publication No. US20020021307) in view of Kudoh (U.S. Patent No. 5,948,058), and further in view of Schindler (U.S. Patent No. 6,081,830). Claim 5 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Glenn in view of Kudoh, and further in view of Schindler and Bezos (U.S. Patent No. 6,525,747). Claim 10 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Glenn in view of Kudoh, and further in view of Schindler and Bunney (U.S. Patent No. 6,446,112).

(3) Argument

Whether Independent Claims 1, 18 and 23 and Dependent Claims 2-17, 19-22, 24-25 and 27-51 are patentable over Glenn in view of Kudoh, and further in view of Schindler

Independent claim 1 recites a method that includes, among other features, first delivering an e-mail message from a sender to at least one recipient. The method includes, upon opening of the e-mail message by the recipient, indicating an online state of one or more of the sender and any other recipient of the email message. The online state, of the one or more of the sender and any other recipient of the email message, lets the at least one recipient know the online status of one or more of the sender and any other recipient of the email.

Independent claim 18 recites a computer program including, among other features, instructions for delivering an e-mail message from a sender to at least one recipient. The program includes instructions for, upon opening of the e-mail message by the recipient, indicating an online state of at least one of the sender and any one other recipient of the e-mail message.

Independent claim 23 recites a communications apparatus configured to, among other features, deliver an e-mail message from a sender to at least one recipient. The apparatus is configured to, upon opening of the e-mail message by the recipient, indicate an online state of at least one of the sender and any one other recipient of the e-mail message.

Examiner's Answer

With respect to the Office's comments on page 3, last paragraph and page 4, lines 1-2; and pages 16-17 under the heading "(10) Response to Argument," the Office has indicated that (1) Glenn does not teach delivering an e-mail from a sender to at least one recipient and the electronic message as an e-mail message. In addition, (2) the Office has relied upon Kudoh to show delivering an e-mail message from a sender to at least one recipient and the electronic message as an e-mail message. However, Glenn was fully aware of e-mail messaging, as

evidenced by Glenn's discussion of e-mail messaging in some of the same portions of Glenn already relied upon by the Examiner. For example, although Glenn's discussion of the use of e-mails is unrelated to the embedding of presence indicators in e-mail messages, Glenn already discusses the use of e-mail messaging (in the same paragraph 0050 referenced by the Office). Therefore, if the Office properly considers the entirety of Glenn's teachings, the Office will realize that e-mails are already described by Glenn in a manner that is in direct contrast to the modification advanced by the Office. In fact, not only was Glenn aware of e-mail messaging, but Glenn does not discuss e-mail messaging in connection with the embodiment which the Office is next suggesting should be modified by Kudoh. For example, the arrangement shown and described in connection with Figs. 2-6 of Glenn, clearly does not describe the use of e-mail messaging in this system. The Office admits this fact, yet appears to suggest that this is merely an oversight on the part of Glenn, and seeks to apply the e-mail messaging of Kudoh to the Glenn system which already avoided e-mail messaging. This hindsight reconstruction of the prior art of record is improper.

Specifically, the Office's suggested modification of the Glenn reference to include features that were already well known to Glenn, and intentionally avoided by Glenn, is an improper hindsight reconstruction of the claimed subject matter. Accordingly, any of the rejections based upon the alleged combination of Glenn in view of Kudoh are improper and should be reversed.

Appellant respectfully requests reversal of the rejection of independent claims 1, 18 and 23 and dependent claims 2-17, 19-22, 24-25 and 27-51, since Glenn, Kudoh and/or Schindler fail to describe or suggest each and every limitation recited in claims 1, 18 and 23. First, the prior art of record does not describe or suggest, *upon opening of the e-mail message by the recipient*, indicating an online state of one or more of *the sender and any other recipient of the email message*. Second, the features of Glenn that are alleged to teach or suggest the above-recited features have been mischaracterized by the Office. Accordingly, the combination of Glenn in view of Kudoh, and further in view of Schindler does not establish a proper prima facie case of obviousness.

In contrast to the recited features of claims 1, 18 and 23, Glenn describes a method and apparatus for first using online presence information that indicates the status of intended recipients of a potential message, e.g., before a message is even sent, presence information is referenced and provided for the sender of a message. See, e.g., Glenn at Abstract, and paragraphs 0020-0022 and 0050-0067. However, a *recipient* of a message is not provided with an indication of online state of one or more of the *sender and any other recipient of the email message*. In Glenn, the user (sender) determines how to send a message only *after* the online presence information of an intended recipient is determined and reviewed by the sender. For example, Glenn describes the method of using online presence information, at paragraph 0043:

The invention provides user with a simplistic mechanism for initiating instantaneous and/or delayed communication channels depending upon whether the receiving user is currently connected to an interconnection fabric. The invention comprises the interconnection fabric configured to transmit data, a plurality of client devices that are each associated with a user and configured to run client programs, a presence indicator, a presence engine, a communication engine, and a broadcast engine. An embodiment of the invention provides a mechanism for translating between multiple types of protocols. Each of these components may be located on a single server computer or split across one or more server computers. A brief overview of these elements and the functionality associated with each element follows.

The following sequence of steps are described by Glenn in each described embodiment. See, e.g., Glenn at Abstract and paragraphs 0050-0067:

1. A presence indicator is generated with information about the *recipient* of a message for a user preparing to send a message, i.e., a *sender*.
2. Presence information concerning the online state of the *recipient* of a message is displayed for the *sender*.
3. A communication interface is provided for the *sender* that determines the proper protocol for sending the message to the *recipient* based on their predetermined on-line state.
4. Either an instantaneous message (such as an instant message protocol) or a queued message (such as an email stored in a server for later delivery when the *recipient* is actually present) is sent only after presence information is considered by the *sender*.

Therefore, in Glenn, the recipient of a message does not receive, upon opening of an e-mail message from a sender, an indication of an online state of one or more of the sender and any other recipient of the email message. Kudoh and/or Schindler do not describe or suggest this feature, and in fact, the Office does not rely upon Kudoh and/or Schindler to identify this feature. Specifically, in rejecting each of the independent claims, the Office specifically relies upon Glenn, citing paragraphs 0021 and 0022 of Glenn (and paragraph 0050 as suggested in clarifying, supplemental comments from the Advisory Action date November 3, 2005), to describe or suggest the features of “upon opening of an e-mail message from a sender, an indication of an online state of one or more of the sender and any other recipient of the email message” recited in claim 1. Paragraphs 0021 and 0022 of Glenn are reproduced below:

[0021] The information retained by the presence engine is communicated to each client device in a binary fashion. When the client device receives the binary information it displays a presence indicator. The presence indicator is a cue that provides users with a way to determine what other users are connected to the network (e.g. a visual, audio, or video cue).

[0022] In one embodiment of the invention, the presence indicator is a graphic that is displayed on a web page. The graphic has multiple states and is associated with a particular user. The graphic is designed to communicate the status of the user with which the graphic is associated. In one state, the graphic indicates that a particular user is connected to the interconnection fabric. In a second state, the graphic indicates that the same user is not using the network. The presence indicator may also be an audio or video cue configured to communicate the states discussed above.

Although the Office has indicated that the above-cited passages describe or suggest a communications method for “upon opening of the electronic message by the recipient, indicating an online state of one or more of the sender and any other recipient of the electronic message (see Glenn, paragraphs 0021 and 0022),” Appellant submits that this interpretation of Glenn is improper. First, paragraphs 0021-0022 of Glenn do not describe any electronic messages between a sender and a recipient of an electronic message, including an e-mail message. Instead, paragraphs 0021-0022 describe a presence indicator that is displayed responsive to communications, in a binary fashion, between the presence engine and each client device. Therefore, these communications are not communications between two client devices, such as a

sender and at least one recipient of an electronic message, but in fact refer to communications between components of the overall system of Glenn, e.g., each client device and the presence engine. The binary communications between the presence engine and the client device described in these passages (0021-0022) are used to create the presence indicator on each client device, e.g., a presence indicator is provided that is indicative of on-line status of other clients. Since the alleged analogous binary communications described in paragraphs 0021 and 0022 are not between two client devices, e.g., a sender and a recipient of an electronic message, this passage cannot be relied upon to describe or suggest indicating online presence information, relating to a sender of a message, to the recipient of an e-mail message.

In an advisory action dated November 3, 2005, the Office reiterates its reliance upon paragraphs 0021-0022 and further clarifies that the binary communication described in paragraphs 0021-0022 includes a target message. Specifically, the Advisory Action states:

A) Applicant's argued that Paragraphs 0021 and 0022 of Glenn cited by examiner does not teach the limitation " upon opening of the electronic message by the recipient, indicating an online state of one or more of the sender and any other recipient of the electronic message

A) Examiner disagrees. Paragraphs 0021 and 0022 of Glenn teach this limitation because they teach displaying a presence indicator upon receiving the binary information, (paragraph 0021) The presence indicator indicates the present a particular user, (paragraph 0022) And the binary information includes target message, which is further explained in paragraph 0050.

As described above, Appellant respectfully submits that the communication conducted in a binary fashion in paragraphs 0021 and 0022 of Glenn does not refer to any target message sent between a sender and a recipient. Instead, the communication is between the presence engine and the individual client devices. Further, neither paragraph 0050, nor any other passage of Glenn, suggests the feature of "upon opening of the electronic message by the recipient, indicating an online state of one or more of the sender and any other recipient of the electronic message." Paragraph 0050 of Glenn is reproduced below.

[0050] Broadcast engine 166 is configured to transmit a message from one user to many users according to a set of criteria. For example, broadcast engine 166 may transmit a targeted message to the user when a certain action occurs (e.g. when a stock reaches a certain price). The broadcast engine 166 may deliver a

single message to many users by generalizing the message into a one-to-many message. The criteria used to determine which recipients to transmit the message data to may be based on membership in a group, demographic information, or any other type of filtering criteria. In one embodiment of the invention, the messages transmitted by broadcast engine 166 comprise advertisements and/or other information to user who are online. Thus, broadcast engine 166 may instantaneously transmit messages to any members of a group who are online (e.g. via an instant messaging client). In one embodiment of the invention, broadcast engine 166 uses communication engine 162 to transmit data. If the members of that group are not presently online, broadcast engine 166 may automatically send the message data via electronic mail. Each message may contain functionality that allows the user to fashion a response to the message. The message may, for example, contain an embedded coupon that allows the receiving user to receive a discount on a particular item if the user clicks on the message. Message recipients may also subscribe to a service by selecting the message.

Paragraph 0050 of Glenn does not refer to communication between the presence engine and the client devices in a binary fashion and/or to the communications between the presence engine and the client device(s) described in paragraphs 0021 and 0022. Specifically, this passage does not clarify or modify the features described in paragraphs 0021 and 0022. The Office has not provided any evidence in Glenn, or the remaining references of the prior art of record, of the recited feature of "upon opening of the e-mail message by the recipient, indicating an online state of one or more of the sender and any other recipient of the e-mail message." Accordingly, the Office has not established a proper prima facie case of obviousness. Therefore, this rejection should be reversed.

In the Advisory Action dated November 3, 2005, the Office further states that:

B) Applicant argues that Glenn fails to teach, "indicating an online state of one or more of the sender."

B) Examiner disagrees Glenn teaches this limitation because Glenn indicates on a document, such as HTML, XML, SGML, or an advertisement banner, whether the correspondent of that particular document is online, (paragraph 0056, paragraph 0061) The correspondent of this document that is sent to user's computer is one of the senders (paragraph 0063) is a target message.

The document that Glenn describes is a document (see paragraphs 0056, 0060, 0061, 0063) that contains an embedded presence indicator. However, the document (elements 156 or

204) of Glenn is not described or suggested as being an electronic message between a sender and a recipient, particularly an e-mail message. Paragraph 0061 of Glenn indicates that Document 204 (FIGs. 2 and 3) is an example of the type of document presence indicator 206 may be embedded into. Specifically, Glenn describes the documents as web pages, online auction announcements or advertisement banners, e.g., "a web page, for example, presence module may comprise code written using a markup language such as HTML, XML, or SGML. However, a presence module may be inserted into any type of document that is to be displayed at the client computer." However Glenn does not describe, in this passage, nor any other passage of Glenn, a presence indicator that is included in an electronic message sent to a recipient, and which identifies the on-line state of the *sender*. Glenn discusses the use of the presence indicator to open a communication interface, e.g., for e-mail or instant messaging. However, Glenn does not describe embedding a presence indicator in an e-mail, an instant message or any other electronic message.

Glenn and/or Kudoh fail to teach or suggest the unique sequence of sending an electronic message first, and indicating the online state of an electronic message sender or recipient upon opening the message. Kudoh describes an e-mail cataloging and retrieving system to facilitate the classification of numerous e-mails with minimal time and effort. See Kudoh, Abstract and col. 3, lines 30-35. Although Kudoh teaches delivery of an e-mail from a sender to at least one recipient, Kudoh is not relied upon to remedy the shortcomings of Glenn, which are discussed above, and fails to do so. Specifically, Kudoh does not remedy the failure, by Glenn, to describe or suggest (1) indicating the online state of one or more of *the sender and any other recipient of an e-mail message* and (2) indicating such an online state *upon opening of the e-mail message* by the recipient, as recited in independent claims 1, 18 and 23.

Further, the Office has curiously and improperly suggested that Glenn fails to discuss the use of e-mail messaging and has therefore relied upon the alleged teachings of Kudoh to overcome this shortcoming, e.g., to modify Glenn so that the documents 204 or the binary communications between the presence engine and the client devices are actually e-mail messages. Although Glenn's discussion of the use of e-mails is unrelated to the embedding of presence indicators in e-mail messages, Glenn already discusses the use of e-mails (in the same

paragraph 0050 referenced by the Office). Therefore, if the Office properly considers the entirety of Glenn's teachings, the Office will realize that e-mails are described by Glenn in a manner that is in direct contrast to the modification advanced by the Office. Specifically, the Office's suggested modification of the Glenn reference to include features that were intentionally avoided by Glenn is an improper hindsight reconstruction of the claimed subject matter. Accordingly, the rejections based upon the alleged combination of Glenn in view of Kudoh are improper and should be reversed.

Schindler

With respect to Schindler, the Office has indicated that this reference teaches a method of indicating the online state of the sender and every other recipient of a chat room. However, Schindler still fails to cure the deficiencies cited hereinabove with respect to Glenn and/or Kudoh. In Schindler, the online state of the sender and every other recipient of a chat room is not sent until presence information is actually reviewed by the sender. Presence information indicating the online state of a *recipient* must be reviewed (and online state confirmed) before Schindler permits the sender to send a message. Accordingly, Schindler does not cure the deficiencies of the alleged combination of Glenn and Kudoh to reveal the presence information of a sender to the recipient. Therefore, this rejection should be reversed.

For at least these reasons, Appellant respectfully requests reconsideration and reversal of the rejections of claim 1, 18, 23, and dependent claims 2-17, 19-22, 24-25 and 27-51.

Accordingly, Appellant respectfully asserts that the prior art references relied upon by the Office fail to teach or suggest all of the claim limitations recited by independent claims 1, 18, and 23. For this reason, *inter alia*, Appellant asserts that a *prima facie* case of obviousness has not been established with regard to the independent claims. Appellant therefore respectfully requests reconsideration and withdrawal of the §103(a) rejection of independent claims, and their respective dependent claims 2-17, 19-22, 24-25, 27-56.

Claim 10 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Glenn in view of Kudoh, and further in view of Schindler and Bunney (6,446,112). As

discussed above with respect to independent claim 1, Glenn, Kudoh and Schindler, either alone or in combination, fail to describe or teach the features of the independent claims, including indicating upon opening of the e-mail message by the recipient, indicating an online state of one or more of the sender and any other recipient of the email message. Bunney does not remedy this shortcoming of Glenn, Kudoh and Schindler. In fact, the Office does not rely upon Bunney to describe or suggest this feature. For at least this reason, and based on its dependency from independent claim 1, Appellant respectfully requests withdrawal of the rejection of claim 10.

Whether Dependent Claims 7 and 8 are patentable over Glenn in view of Kudoh, and further in view of Schindler

As described above with respect to claims 7 and 8, Appellant submits that claims 7 and 8 are patentable due to their dependence upon claim 1. In addition, Appellant submits that claims 7 and 8 are patentable for the features provided therein.

Claim 7 recites that the graphical user interface comprises an icon positioned next to an e-mail address in the e-mail message (see FIG. 10 of the present application, exemplary running man icons next to e-mail addresses). Further, claim 8 recites indicating the online state comprises indicating whether the sender is online, offline, or not a member of the communications system (see FIG. 10, various user interfaces provided depending upon online state). Appellant submits that these features have not been described or suggested in the prior art of record.

The Office has indicated that Glenn describes a graphical user interface comprises an icon positioned next to an e-mail address in the e-mail message and/or indicating the online state comprises indicating whether the sender is online, offline, or not a member of the communications system. See Final Office Action dated May 5, 2005, page 4. Appellant submits that Glenn cannot reasonably stand for the teaching that a graphical user interface comprises an icon positioned next to an e-mail address, if the Office has concurrently indicated that Glenn does not describe or suggest delivering an e-mail message from a sender to at least

one recipient and the electronic message as an e-mail message. See Final Office Action dated May 5, 2005, page 3, lines 1-7. Accordingly, this rejection should be reversed.

Whether Dependent Claim 5 is patentable over Glenn in view of Kudoh, and further in view of Schindler and Bezos.

Claim 5 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Glenn in view of Kudoh and further in view of Schindler and Bezos (6,525,747). As discussed above with respect to independent claim 1, Glenn, Kudoh and Schindler, either alone or in combination, fail to describe or teach the features of independent claim 1. Bezos does not remedy the failure of Glenn, Kudoh and Schindler, e.g., specifically Bezos does not describe or suggest upon opening of the e-mail message by the recipient, indicating an online state of one or more of the sender and any one other recipient of the e-mail message. For at least this reason, and based on its dependency from independent claim 1, Appellant respectfully requests withdrawal of the rejection of claim 5.

Further, Appellant submits that the alleged combination does not describe or suggest the recited feature of claim 5 of the e-mail message comprises an invitation to join the communications system. Glenn, Kudoh and/or Schindler do not describe or suggest this feature. In fact, the Office acknowledges that Glenn, Kudoh and/or Schindler do not describe or suggest this feature. See Final Office Action dated May 5, 2005, page 13. Although the Office has relied upon Bezos to overcome this shortcoming, Appellant submits that it would not have been obvious to modify Glenn in view of Kudoh, and further in view of Schindler to include the e-mail message including an invitation to join the communications system. As recited in claim 1 and 5, the indicating an online state of one or more of the sender and any other recipient of the e-mail message purposefully reveals the online state of one or more of the sender and any other recipient of the e-mail message. The invitation to join a private discussion, see col. 7, lines 1-31 of Bezos, the identities of the participants of the e-mail are kept confidential from the requesting user. Accordingly, Appellant submits that combining Bezos with the modified method of Glenn, Kudoh and Schindler would not result in any system or method that

would indicate the online state of one or more of the sender and any other recipient of the e-mail message, wherein the e-mail message includes an invitation to join the communication system. As recited in claim 5, the indication of the online state of one or more of the sender and any other recipient of the e-mail are revealed to the recipient upon opening of the e-mail. In contrast, Bezos does not reveal online state or identity of the sender or other recipients unless the recipient joins the communication system after receiving the message.

Whether Independent Claim 26 and Dependent Claims 52-56 are patentable over Glenn in view of Kudoh, and further in view of Schindler

Independent claim 26 recites a communications apparatus including, among other features, delivering means for delivering an e-mail message from a sender to at least one recipient. The apparatus includes indicating means for indicating an online state of at least one of the sender and any one other recipient of the e-mail message upon opening of the e-mail message by the recipient.

As discussed with respect to claims, 1, 18 and 23 above, Appellant submits that the prior art of record does not describe or suggest an apparatus for indicating an online state of at least one of the sender and any one other recipient of the e-mail message upon opening of the e-mail message by the recipient. In addition, in accordance with 35 U.S.C. § 112, sixth paragraph, Appellant submits that the prior art of record does not describe or suggest indicating means for indicating an online state of at least one of the sender and any other recipient of the e-mail message upon opening of the e-mail message by the recipient.

Various exemplary user interfaces, such as graphical user interfaces, are described at page 18, line 24 through page 22, line 3 of the specification. Figs. 8-10 show various user interfaces, such as UI 900 providing indications of an online state. The alleged analogous online auction document of Glenn (see FIG. 2 and 3 of Glenn) does not contain a user interface for viewing e-mail messages and means for indicating an online state of at least one of the sender and any other recipient of the e-mail message upon opening of the e-mail message by the recipient).

Accordingly, claims 26 and 52-56 are patentable over the prior art of record.

Whether Dependent Claims 52-56 are patentable over Glenn in view of Kudoh, and further in view of Schindler

As described above, Appellant submits that claims 52-56 are patentable due to their dependence upon claim 26. Further, the "FROM:" and "TO" reference lines in the user interface of FIG. 10 and/or the buddy list (FIG. 10) provide further indication of an online (or offline) state of users (one or more recipients and/or the sender of an e-mail message) within the UI 900. Appellant submits that these features have not been described or suggested by the alleged combination of Glenn in view of Kudoh, and further in view of Schindler. The alleged analogous user interface of Glenn is an on-line auction site. Glenn, Kudoh and/or Schindler do not describe or suggest a user interface that provides indications, a user interface, of at least one of the sender and any other recipient of the e-mail message upon opening of the e-mail message. Therefore, indicating means for indicating the online state of the sender of the e-mail message, at least one other recipient of the e-mail message, both the sender and at least one other recipient of the e-mail message, and/or both the sender and every other recipient of the e-mail message is not taught or suggested by the prior art of record. Since Glenn does not describe an e-mail messaging system, Appellant submits it is unreasonable to suggest that Glenn describes indicating the online state of the sender, recipient(s), or both the sender and recipient(s) of an e-mail message.

Appellant submits that all of the claims are patentable over the prior art of record.

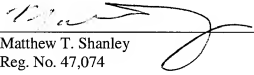
For these reasons, and the reasons stated in the Appeal Brief, Appellant submits that the final rejection should be reversed.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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Matthew T. Shanley
Reg. No. 47,074

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331